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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/587,201

licant(s)

LIBERMAN, BARNET L

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-46 and 48-62 is/are pending in the application.
- 4a) Of the above claim(s) 48-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8. 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. The amendment filed November 16, 2003 (Paper No. 9) is acknowledged. Accordingly, claims 1-46 and 48-62 remain pending.
2. This application contains claims 48-62 drawn to an invention nonelected without traverse in Paper No. 6.
3. This Office Action is written in OACS. Because of this, the Examiner may be unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.

Specification

4. The disclosure is objected to because of the following informalities:

Page 7, "Figure 8A" which describes the figure as an "alternative bag." This statement is in direct opposite to Applicant's statement that Figure 8A is not a different species (thus it is not an alternative embodiment of the bag).

Appropriate correction is required.

Drawings

5. The drawings are objected to under 37 §C.F.R. 1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claim(s):

1. The "ordering, by a customer, the grocery item" as recited in claims 5 and 21.

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2. The step containing "accepted before a cutoff time of a first day" as recited in claim 22.
3. The "travel radius" as recited in claim 26.
4. The "desired temperature" as recited in claim 25.
5. The "step of placing the tote into the first vehicle" by "placing the rack with the tote thereon into the first vehicle" as recited in claim 32.
6. The Examiner again notes the claims are replete with the above drawing errors. For example, the Examiner has located at least 5 drawing errors. It is also clear that all method steps recited in claim 2-47 are clearly not shown in the drawings. The Examiner notes that this application contains only *a single flowchart* for all 46 claims. The Examiner *highly recommends* Applicant review all pending claims to ensure that every method step claimed is shown in the drawings (and preferably in flow chart form). To show no new matter is found in the drawings, the Examiner respectfully requests Applicant to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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8. Claims 15 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not disclosed how one of ordinary skill in the art would maintain a desired temperature by feeding a chilled gas into at least a portion of the tote. If Applicant expressly admits on the record that such procedures are old and well known in the art *and* provides appropriate evidence in support thereof (*e.g.*, a U.S. Patent disclosing these features), this particular rejection will be withdrawn.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1, 5, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Klots et. al. (U.S. 6,622,127 B1) ("Klots"). Klots discloses placing a grocery item (*e.g.* milk) ordered by a customer in a tote (the tote); placing the tote onto a removable rack (the dolly) in a warehouse; transferring the rack with the tote therein into a first vehicle (the delivery vehicle); and dispatching the first vehicle to deliver the grocery item (inherent); ordering by the customer my

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means of the Internet, phone, email or fax (order filling software); and a plurality of warehouses (inherent).

11. Claims 16, 17, 21, 23, 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Porter (U.S. 6,429,699 B1) ("Porter '699"). Porter '699 discloses receiving a grocery item (*e.g.* rice) ordered by a customer in a tote (the rice bag); delivering the tote into a secure expandable, insulated bag (104) attached to a box (102) situated outside the delivery destination; ordering by the customer over the Internet; maintaining the item at a desired temperature and using a frozen insert (*e.g.* a box of frozen pizza) in proximity to the grocery item.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klots. Klots discloses as discussed above but does not directly disclose a second vehicle. It is now admitted prior art that that objects are delivered to customers with more than one vehicle or carrier and that the second vehicle or carrier may be smaller than the first vehicle or carrier. (See "Official Notice" in 'Response to Arguments' noted below.) Moreover, because Applicant's Figure 2

represents 160 and 180 in block form, the features in block form are interpreted in accordance with 37 C.F.R. §1.83(a) as “conventional.”¹

It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klots to include the second vehicle or carrier being smaller so that the smaller vehicle or carrier could travel in smaller places such as narrow streets. Many roads have restriction on tonnage of vehicles. If the delivery vehicle in Klots could not drive down particular roads, or in particular tunnels, or travel over particular bridges, the goods must then be transferred to a smaller delivery vehicle.

14. Claims 6, 14, and 15, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Klots in view of ‘Peapod I’. Klots discloses as discussed above but does not directly disclose a cutoff time for delivery. ‘Peapod I’ discloses delivering groceries within a specific time and day and using frozen inserts (*e.g.* a box of frozen pizza will help keep the milk cold). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Klots as taught by ‘Peapod I’ to include the claimed limitations. Such a modification would have given customers assurance as to ‘when’ there groceries would be delivered.

15. Claims 7 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Klots in view of ‘Peapod I’. Klots discloses as discussed above but does not directly disclose a cutoff time for a vehicle travel distance. ‘Peapod I’ discloses that delivery vehicles travel a particular distance to the customer’s homes (otherwise a delivery would be impossible). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify

¹ Conventional “**c (1)** : ORDINARY, COMMONPLACE” Merriam-Webster’s Collegiate Dictionary,

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Klots as taught by 'Peapod I' to include a travel radius being the distance a vehicle can travel within approximately 6 hours. Such a modification would allowed the driver to have a reasonable work day of 12 hours allowing him or her to travel a maximum of 12 hours (6 hours 'to' and 6 hours 'back') for at least a single delivery.

16. Claims 8-12, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Klots in view of Porter '699. Klots discloses as discussed above but is silent as to how the groceries are delivered. Porter '699 teaches teaches as discussed above including a secure expandable insulated bag (104) attached to a box (102) to secure the delivered goods; storing the bag in the collapsed state when the bag is not in use; the bag having a first lock (using keypad 60) and a second lock (which locks the enclosure to prevent theft).

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Klots as taught by Porter '699 to allow for secure delivery of groceries while the customer was unavailable and having the receptacle take up as little space as possible when not in use.

Moreover, one of ordinary skill in the art would further modify Porter '699 by expanding the upper section (in Figure 10) in order to enclose the bag (104) with the entire upper section. Such a modification would have kept the lower bag dry preventing moisture from seeping through the bag in windy and rainy conditions while in the stored position.

17. Claims 18-20, 25, 27-32, 34-43, and 45, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter '699. Porter '699 discloses as discussed above but does not directly disclose storing the bag within the box. However, it would

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have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Porter '699 by expanding the upper section (in Figure 10) in order to enclose the bag (104) with the entire upper section. Such a modification would have kept the lower bag dry preventing moisture from seeping through the bag in windy and rainy conditions while in the stored position.

As noted above, it is now admitted prior art that that objects are delivered to customers with more than one vehicle or carrier and that the second vehicle or carrier may be smaller than the first vehicle or carrier. It therefore would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Porter '699 to include the second vehicle or carrier being smaller so that the smaller vehicle or carrier could travel in smaller places such as narrow streets. Again, many roads have restriction on tonnage of vehicles. If the delivery vehicle in Klots could not drive down particular roads, or in particular tunnels, or travel over particular bridges, the goods must then be transferred to a smaller delivery vehicle.

18. Claims 22, 26, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter '699 in view of 'Peapod I.' Porter '699 discloses as discussed above but does not directly disclose a cutoff time for a vehicle travel distance. 'Peapod I' discloses as discussed above in addition to delivery vehicles traveling a particular distance to the customer's homes. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to again modify Porter '699 as taught by 'Peapod I' to include a travel radius being the distance a vehicle can travel within approximately 6 hours. Such a modification would allowed the driver to have a reasonable work day of 12 hours allowing him or her to travel a maximum of 12 hours (6 hours 'to' and 6 hours 'back') for at least a single delivery.

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19. Claims 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Porter '699 in view of Fullington et. al. (U.S. 3,628,807) ("Fullington"). Porter '699 discloses as discussed above but does not directly disclose a second tote that falls into a place previously occupied by the first tote. Fullington teaches using a slanted cart to store grocery items.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Porter '699 to include expanding on the rack system by including the Fullington rack whereby a second tote that falls into place previously occupied by the first tote by at least one of gravity and the agitation of the movement of the vehicle. Such a modification would have helped insure that the first-in-first-out ("FIFO") system needed to reduced spoilage of perishable products is successfully implemented.

20. Claims 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipowsky et. al. (U.S. 2,159,279) ("Lipowsky") in view of Porter (U.S. 5,774,053) ("Porter '052"). Lipowsky discloses a bag which can contain a tote (a donut box in which a dozen donuts are in); securing the tote within the bag (inherent); placing a grocery item ordered by a customer within a tote (the donuts must somehow be placed in the donut box) (the donut box is then placed within 15). Lipowsky does not directly disclose placing the bag (15) within the box.

Porter '052 teaches a box (10) to delivered goods. Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lipowsky as taught by Porter '052 and store bag Lipowski's bag (15) in the Porter's box while not in use. Such a modification would have prevented Lipowski's bag (15) which is made of fabric from getting wet and moldy every time it rains. Moreover, the two storage areas would have provided extra storage space if box (15) became full.

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21. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,² the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements.³ Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,⁴ Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography is invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation⁵ to be his own lexicographer.⁶ Accordingly and

² See the Examiner's previous Office Action mailed July 16, 2003, Paper No. 7, Paragraph No. 29.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ See again the Examiner's previous Office Action, Paper No. 7, Paragraph No. 29.

⁵ *Id.*

⁶ The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner.

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for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their "broadest reasonable interpretation" *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁷ The Examiner now relies heavily and extensively on this interpretation.⁸ Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

22. Under the broadest reasonable interpretation standard noted above, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions, like the definitions contained in this Office Action, are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner's claim interpretations during ex parte examination. Therefore, to the extent that the Examiner's interpretations are different from

Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed January 25, 2004).

⁷ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) ("In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification") (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

⁸ See 37 C.F.R. §1.104(c)(3) which states in part: "the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability" [Emphasis added.]

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Applicant's interpretations, the Examiner additionally adopts the following definition(s)—under the broadest reasonable interpretation standard—in all his claim interpretations. Finally, the Examiner notes that the following definition(s) are not exhaustive in any way.

a. **Internet** “The worldwide collection of networks and gateways that use the TCP/IP suite of protocols to communicate with one another. At the heart of the Internet is a backbone of high-speed data communication lines between major nodes or host computers, consisting of thousands of commercial, government, educational, and other computer systems, that route data and messages.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.⁹

b. **Item**: “2 : a distinct part in an enumeration, account, or series : ARTICLE” Merriam-Webster's Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

23. The Examiner concludes that Applicant has decided that the examined claims do not contain any product-by-process limitations. The Examiner now relies heavily and extensively on this interpretation. See the Examiner's previous Office Action mailed July 16, 2003, Paper No. 7, Paragraph No. 31.

⁹ Based upon Applicant's disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See *e.g. Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the Microsoft Press Computer Dictionary (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and MPEP§2173.05(a) titled ‘New Terminology.’

Response to Arguments

24. Applicant's arguments filed with his amendment on November 16, 2003 (Paper No. 9) have been fully considered but they are not persuasive.

Objections to the Specification

25. Applicant's response is acknowledged. Applicant apparently does not understand what are species. Applicant 'Remarks/Arguments'¹⁰ on page 14 basically restates the Examiner's Office Action, concludes no correction is required, recites his response to the last restriction/election of species, and then concludes there is no contradiction. As noted in the Examiner's 'Election of Species' in Paper No. 5, and again after further review of Figures 3, 5A, and 8A, the embodiments represented in Figures 3, 5A, and 8A are alternative embodiments. As noted in the previous Office Action,¹¹ Applicant's specification expressly confirms that Figure 8A is an alternative embodiment.

26. The Examiner will again assume that Applicant intends to argue that the claims are generic therefore the election of species is not required.

27. It is the Examiner's factual determination that the species represented by Figures 3, 5A, and 8A are not patentably distinct. Because the species are not patentably distinct, the Election of Species (Paper No. 5) was withdrawn (in Paper No. 7). The Examiner continues to rely heavily and extensively on this finding. Also as noted in the previous Office Action, if Applicant

¹⁰ See Applicant's "Remarks/Arguments" filed November 16, 2003, Paper No. 9, beginning on Page 13.

¹¹ Office Action mailed July 16, 2003 (Paper No. 7), Paragraph No. 9.

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argues that the species are patentably distinct either directly or indirectly, the Election of Species noted in Paper No. 5 will most likely be reinstated.

28. The Examiner notes that as is most often the case, election of species issues arise when the application is replete with drawing errors.

Objections to the Drawings

29. Applicant states the exemplary 'errors' are not errors and states that "it is unclear what sort of 'errors' for which the applicant should look in the remaining claims." Although this appears to be self evident, Applicant should review each pending claim and locate all method steps from the claim in the drawings. If the drawings do not show the method step, Applicant should remove the method step from the claim, or modify his drawings. Moreover, all structural limitations that effect the method steps in a manipulative sense must also be shown. If the drawings do not show the structural elements, Applicant should remove the structural elements from the claim, or modify his drawings.

30. Applicant argues that "a patent application need not graphically depict every conceivable element of invention as long as it details essential factors; rejection of claim [sic] for lack of showing in the drawing alone is not tenable." To support his position Applicant cites *Harrington v. White*.

31. First, 37 C.F.R. §1.83(a) states in part:

(a) The drawings in a nonprovisional application *must show every feature* of the invention specified in the claims. However, conventional features ... should be illustrated in the drawing in the form of a graphical drawing symbol or labeled a representation (e.g. a labeled rectangular box). [Emphasis added.]

32. The rule expressly states that the “application must show every feature of the invention specified in the claims.” *Id.* To the Examiner, this rule is clear on its face. In other words, if its in the claims, it must be shown in the drawings. For these reasons alone, Applicant’s arguments are unpersuasive.

Second, whether or not a drawing shows “essential factors” according to *Harrington* is immaterial. Moreover, the drawings are ‘objected to’ and this Office Action does not contain a “rejection” of the drawings as attributed to *Harrington*.¹² Therefore *Harrington* is not on point. Even if *Harrington* was on point (albeit a big ‘if’), the decision is a 5th Circuit opinion and therefore not binding upon the Examiner.¹³ For these reasons alone, Applicant’s arguments are unpersuasive.

33. Moreover, one reason for requiring an applicant to show all his method steps is to assist the public (and examiners)—once applicant’s application issues as a patent—in ascertaining the invention so that applicant’s published patent can be used against others as prior art. U.S. patent application numbers ‘US 2002/0096320 A1,’ ‘US 2002/00997406 A1,’ and ‘US 2002/0102749 A1’ are published applications with 5,395 claims, 6,632 claims, and 6,632 claims respectively!¹⁴ How does an applicant reasonable expect the public to follow and comprehend such applications without a flow chart for the method claims? While Applicant’s current application does not contain the number of claims listed above, the reasoning is still the same.

¹² See MPEP §706.01 for a discussion on the distinction between objections and rejections.

¹³ Decisions considered to be binding precedent by the Federal Circuit are decisions of the former Court of Claims and the former Court of Customs and Patent Appeals, as well as the former Customs Court. *Ex parte Holt*, 19 USPQ2d 1211, 1214 (B.P.A.I. 1991) (citations omitted).

Theoretically, Applicant is also free to recite over 6000 claims (although the Examiner *strongly* encourages Applicant not to do this). Published patents within class 705 are now routinely issuing with specifications over 100 pages. Whether its 62 claims or 6000 claims, unless the claimed method steps are shown in the drawings (and preferably in flow chart form), it is extremely difficult to comprehend the invention (for prior art purposes) while searching unless the claimed features are shown in the drawings.

2. Finally, Applicant is apparently arguing that “ordering,” “maintaining,” and “establishing” are inherent in the figures. If understood correctly, Applicant argues that these shown steps (*e.g.* in Figure 1) inherently includes the steps of “ordering,” “maintaining,” and “establishing” and need not be shown in a separate drawing. The Examiner respectfully disagrees.

If applicants were allowed to follow such a practice, drawings of systems could be illustrated as a single drawing with a single box labeled ‘System’ while method claims could be illustrated with two rectangular boxes in flow chart form labeled ‘Method Steps.’ Applicant’s current argument that the claimed features are inherent within the boxes labeled ‘Method Steps’ would then be appropriate. This line of reasoning clearly defeats the principle purpose of the drawings: “for the understanding of the subject matter sought to be patented.”¹⁵ Furthermore, because issues of how much patentable weight to give structural limitations in method steps

¹⁴ A search reveals that there are over 50 published applications with at least 5000 claims.

¹⁵ 35 U.S.C. 113 (1999).

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continually arise, Applicant's delineation of what specifically are the steps in their claims is of great importance. For these reasons alone, Applicant's arguments are unpersuasive.

35 U.S.C. §112 1st Paragraph

34. Regarding the 35 U.S.C. §112 1st paragraph rejection, the previous Office Action stated

If Applicant expressly admits on the record that such procedures are old and well known in the art *and provides appropriate evidence* in support thereof (i.e. a U.S. Patent), this particular rejection will be withdrawn. [Emphasis added.]¹⁶

35. While Applicant has clearly met step one, Applicant has failed to provide *any* evidence in support of his position as requested by the Examiner. Therefore, the 35 U.S.C. §112 1st paragraph rejection remains.

Prior Art Rejections

36. Applicant states "As admitted by the Examiner, Wilson does not teach every element of claim 1" ¹⁷ First, this statement simply false. As noted above, the Examiner stated "Wilson discloses" Moreover, "[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). It was the Examiner's factual determination all features in claim 1 are disclosed or inherent in Wilson.

37. The Examiner highly recommends Applicant review the previous Office Action. In the future and to avoid clouding the prosecution record with inaccurate statements, if Applicant

¹⁶ Paper No. 7, Paragraph No.

¹⁷ Paper No. 9, Page 18, line 3.

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intends to attribute statements to the Examiner, the Examiner now requests that Applicant specifically quote the Examiner.

38. Next, it is the Examiner's position that Applicant's reliance on *Continental Can* is misplaced. First, *Continental Can* stands for the proposition that inherency, like anticipation itself, requires a determination of the meaning of the prior art. Second, *Continental Can* fails to consider the *standard* the Examiner must meet to show inherency.

39. Other than the items noted below, the other comments regarding the prior art are moot in view of the new grounds of rejection noted above.

Official Notice

40. Applicant's attempt at traversing the Official Notice findings as stated in the previous Office Action (Paper No. 7, Paragraph Nos. 22 and 23) is inadequate. Adequate traversal is a two step process. First, Applicant must state his traversal on the record. Second and in accordance with 37 C.F.R. §1.111(b) which requires Applicant to specifically point out the "supposed errors" in the Office Action, Applicant must state *why* the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while Applicant has apparently met step (1), Applicant has failed step (2) since he has failed to argue *why* the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant's traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP §2144.03.

41. In this case, Applicant's arguments appear to be attacking the Examiner's *choice* of facts. In other words, Applicant's response does not challenge the veracity of the statement itself but

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instead challenges which particular facts the Examiner took Official Notice of. This is akin to challenging the Examiner's choice of references. While the Examiner acknowledges Applicant's arguments are pertinent when traversing the *rejection* itself (because of the 'all elements' rule), but such arguments are completely immaterial when ascertaining whether or not Applicant has properly traversed the Official Notice statement. Because of Applicant's confusion on this matter, Applicant should contact the Examiner at the telephone number noted below for additional information on how to properly traverse an Official Notice statement.

Lexicography

42. The Examiner acknowledges Applicant's response in §XI of his response characterizing the Examiner's section on lexicography. For purposes of 37 C.F.R. §1.181(c), the Examiner's position regarding lexicography invocation is again repeated.

43. To be clear, it is entirely possible Applicant may not act as his own lexicographer.

Applicant should again review Paragraph No. 29 from the previous Office Action and understand that the Examiner's lexicography paragraph is essentially only reminding Applicant that his response must comply with *all* applicable rules, including 37 C.F.R. §1.111(b).¹⁸ Nothing more is required.

¹⁸ For guidance on how the USPTO interprets 37 C.F.R. §1.111(b) see *e.g.*: MPEP §818.03(a) quoting §1.111(b) and noting that applicant is required to point out the supposed errors in the next response by stating why the Examiner's position regarding restriction is substantively incorrect in order to preserve his or her right to petition; MPEP §2144.03 regarding Official Notice, citing §1.111(b), and noting that traversal must be made in applicant's next response. "A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement is made. [Emphasis added.]" Failure to seasonable challenge the official noticed statement means the statement is interpreted as admitted

Definitions

44. The Examiner acknowledges Applicant's response in §XI of his response characterizing the Examiner's section on the definitions provided. As noted above and for purposes of 37 C.F.R. §1.181(c), the Examiner's position regarding the definitions is again repeated.

45. Applicant states that he does not have "any specific guidance [] as to how the Examiner is applying those definitions to the claims."¹⁹ While most definitions are usually cited because those terms are found in the claims, the Examiner may have provided additional definitions (*e.g.*, in this case *computer*) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art. One point however is clear, such comments by Applicant unmistakably confirm that Applicant has received notice of the Examiner's factual findings and legal conclusions and has been given the opportunity to defend against the corresponding noticed liabilities.

Preamble

46. In response to Applicant's arguments, the recitation "using a hierarchy of containment structures" has been considered²⁰ but given little patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely

prior art; and *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive §1.111(b) and that according to §1.111(b), applicant is required to point out any "supposed errors" in his next response.

¹⁹ Applicant's Remarks/Arguments, Paper No. 9, Pages 27 and 28.

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recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Conclusion

47. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

48. The following references are pertinent to Applicant's disclosure: McCormick et. al. (U.S. 6,612,489 B2); Jones (6,510,383 B1); Rosenberg et. al. (U.S. 6,418,416 B1); Madruga (U.S. 6,347,737 B1); Livesay et. al. (U.S. 6,339,764 B1); and Kindell (U.S. 5,979,750).

²⁰ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

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49. The following two (2) citations to the Manual of Patent Examining Procedure (“MPEP”) apply to this Office Action: MPEP citations to Chapters 200, 700, 1800, and 2100 are from the MPEP 8th Edition, Rev 1, February 2003. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

50. Because this application is now final, Applicant is reminded of the USPTO’s after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is not a matter of right. “The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion.” *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

51. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his position

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regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his "Remarks/Arguments" (Paper No. 9, beginning on page 13) traversing the Examiner's positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied²¹, the Examiner respectfully reminds Applicant to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) *in his next properly filed response*. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has *any* questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Patent Examiner
Art Unit 3627

AJF
January 25, 2004

²¹ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.